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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,280	01/04/2002	Jay A. Murdock	LEAR 0960 R	6835

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BROOKS KUSHMAN P.C. / LEAR CORPORATION
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075-1238

EXAMINER

PEDDER, DENNIS H

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,280

Applicant(s)

MURDOCK ET AL.

Examiner

Dennis H. Pedder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17, 19, 20, 23-27, 29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-4 and 29 is/are allowed.
- 6) ☒ Claim(s) 5-11, 13-17, 19, 20, 23-27 and 31 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,010,174 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

2. Claims 5-11, 13-17, 19-20, 23-27, 31 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The subject of recapture is a complicated one. Applicant is referred to the decision in Ex parte Eggert, 67 USPO2D 1716, US PATENT AND TRADEMARK OFFICE, BOARD OF PATENT APPEALS AND INTERFERENCES, a en banc decision and thus precedential for a clarifying discussion of this issue.

Note that two terms are central: 1) surrendered subject matter, a claim surrendered to the public as not patentable, represented by the outer circle, and 2) the shaded area of the drawing 1, which is sometimes referred to as the surrender limitation. Pages 1-5 of this decision outline the substantive issues for applicant. Parent application claim 1 was surrendered to the public when application claims 2, 3, and 4 were incorporated therein to obtain allowance for patented claims 1, 3, and 4. No argument is necessary to surrender subject matter. Applicant's actions in not arguing the rejection of the parent file and incorporating the subject matter of claims 2-4 is sufficient action to surrender the subject matter of parent application claim 1. As such application claim 1 has been subject to administrative review and applicant has surrendered same to the public, the limitations therein are not subject to reissue and must be included in any reissue claim in this application. Application claims 2,3,4 fall within the shaded area of the drawing and as such are subject to the question of recapture as claims that fall within the shaded area have not been subject to the administrative process of examination and thus may be considered for reissue. However any reissue claim must have all of the limitations of application claim 1 present as applicant has by his action of incorporation, conceded that claim 1 is in the public domain. As application claim 1's limitations are not present in

any of the claims 5, 16, and 31 of this reissue application, the issue of whether the reissue claims are related to the claim limitations (application claims 2,3,4) added to obtain patentability (shaded area) is moot at this time. However, see comments below.

Specifically, relating to the claims of this application, claims 5 and 31 omit the limitation “said track forming a substantially enclosed longitudinally extending passage adjacent one surface of the visor body”. Claim 16 omits that it is the track that forms the passage and the passage receives the guide. Until such limitation is added to these claims, the recapture rejection will continue to apply and no reissue patent can be granted.

Regarding the surrender limitation discussed above, application claims 2-4 dealt with the shape of the guide cross section, the shape of the track receiving the guide, and the shape of the guide at the track, respectively. Inasmuch as claims 5, 16, and 31 recite aspects of the shape of the guide, these limitations may be considered, in the future, with regard to broadening of the surrender limitation at such time, if ever, as the surrendered subject matter is restored to the body of these claims.

Claim 29 of this application narrows the surrendered subject matter of application claim 1 in a manner not related to the surrender limitations listed above and thus is *not* subject to recapture by the above analysis.

The former analysis above is substantially repeated. It is believed that applicant is mistaken in analysis of the case law governing recapture and that the position taken by applicant is illogical as follows: Eggert was correctly cited in stating that “the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter appellants conceded was unpatentable”. This is the subject matter of application claim 1.

As applicant is attempting to broaden this subject matter, now conceded to the public domain by applicant's non-traversal of the prior rejection and failure to appeal same, applicant is attempting to recapture that surrendered subject matter. Applicant's statement in this regard that "the rejected claims "are (1) not equal in scope to the surrendered subject matter, nor (2) are they broader than the surrendered claim" is correct as to item (1) but clearly incorrect as to item (2) by the omissions of claims 5 and 16 and 31 discussed above.

The examiner concedes the complexity of the above analysis, but is firm in repeating the above aspects of the rejection. Applicant may wish to solicit further opinion of the Board of Appeals, the author of the above case law for an edifying analysis.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 5-7, 13-16, 19, 23-24, 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark.

As to claim 5, Clark has rod 30, torque control 54/56 with first pivotal attachment at both left and right ends in figure 6 in guide 58/60 with legs 58, visor body 22 with structure 94 partially circumscribing the rod and a pivotal attachment where the rod enters the rib 94, attachments 58 are slidably engaged to the rod, and track 72, 74 cooperating with legs 58 at apertures 59 allowing relative sliding longitudinal movement. As to claim 16, the pivotal attachments are coaxial and the control maintains a rotation position with respect to the rod, track visor body and the visor body pivotal attachment. As to claim 7, the tracks 72,74 are fixed to members 80, in turn fixed to the visor body. As to claims 13-14, see the contact in figure 5 as compared to figure 4. As to claim 23, the tracks 72,74 project in longitudinal direction along the visor body. As to claim 24, the outer circumference of the tracks 72, 74 is a free edge. As to claims 15, 27 the second pivotal attachment of the visor body projects for the body along its upper surface.

Allowable Subject Matter

3. Claims 1-4, 29 are allowed.
4. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 8-11, 17, 20, 25 continue to be rejected under 35 USC 251, but do not appear rejectable under the Clark reference above.

Response to Arguments

6. Applicant's arguments filed 8/26/2004 have been fully considered but they are not persuasive.

The rejections above are believed to be fully explained.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

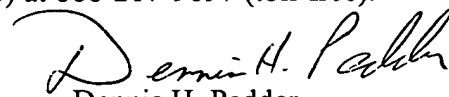
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis H. Pedder whose telephone number is (703) 308-2178. The examiner can normally be reached on 5:30-2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dennis H. Pedder
Primary Examiner
Art Unit 3612

3/10/05

DHP